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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE F. MCINTYRE,
CHRISTOPHER C. CEGELSKI,
and JOHN K. MCBRIDE

Appeal 2009-0710
Application 09/973,031
Technology Center 3700

Decided:¹ March 10, 2009

Before TERRY J. OWENS, JENNIFER D. BAHR, and
STEFAN STAICOVICI, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1, 3-12 and 32. Claim 2 has been canceled, claims 13-31 have been withdrawn from consideration by the Examiner, and claim 33 stands objected to as dependent from a rejected claim but allowable if rewritten in independent form. We have jurisdiction under 35 U.S.C. § 6(b).

The Invention

The Appellants claim an image product comprising a dual sided album leaf having a pocket, and an insert which is placeable in the pocket and has information thereon related to images on the album leaf. Claim 1 is illustrative:

1. An image product assembly, comprising:

a dual sided album leaf having a first ply layer and a second ply layer, said first and second ply layers each having an outer surface and an inner surface, said first and second ply layers are secured together so as to form a pocket there between, said outer surface of said first and/or second ply layer having a plurality of images formed thereon; and

an insert having a size and configuration such that it can be placed within said pocket, said insert having information thereon that relates to said plurality of images, said information on said insert is located in a position on said insert such that it can be readily identified with respect to which of said plurality of images it is associated.

The References

Fountain	370,186	Sep. 20, 1887
Hawley	3,848,348	Nov. 19, 1974
Bromer	5,445,417	Aug. 29, 1995
Young	6,061,938	May 16, 2000
Liener Chin	6,632,042 B1	Oct. 14, 2003

The Rejections

The claims stand rejected as follows: claims 1, 3 and 12 under 35 U.S.C. § 102(b) over Bromer; claims 5 and 6 under 35 U.S.C. § 103 over Bromer in view of Fountain; claim 7 under 35 U.S.C. § 103 over Bromer in view of Young; claims 8-11 under 35 U.S.C. § 103 over Bromer in view of Hawley; claim 32 under 35 U.S.C. § 103 over Bromer; claims 1, 4 and 12 under 35 U.S.C. § 102(b) over Liener Chin; and claim 4 under 35 U.S.C. § 103 over Bromer in view of Liener Chin.

OPINION

We reverse the rejections of: claims 1, 3 and 12 under 35 U.S.C. § 102(b) over Bromer, claims 5 and 6 under 35 U.S.C. § 103 over Bromer in view of Fountain, claim 7 under 35 U.S.C. § 103 over Bromer in view of Young, claims 8-11 under 35 U.S.C. § 103 over Bromer in view of Hawley, and claim 32 under 35 U.S.C. § 103 over Bromer, and affirm the rejections of claims 1, 4 and 12 under 35 U.S.C. § 102(b) over Liener Chin and claim 4 under 35 U.S.C. § 103 over Bromer in view of Liener Chin.

*Rejection of claims 1, 3 and 12 under
35 U.S.C. § 102(b) over Bromer*

Issue

Have the Appellants shown reversible error in the Examiner's determination that Bromer discloses, expressly or inherently, 1) a dual sided album leaf having first and second ply layers secured together to form a pocket therebetween and having a plurality of images on the first and/or second ply layer, and 2) an insert having information thereon such that when the insert is placed within the pocket, it can be readily identified with respect to which of the plurality of images the information is associated?

Findings of Fact

Bromer discloses a “presentation folder which may also be used as a report cover, a notebook cover or a page protector” (col. 1, ll. 34-35) and which may be an insert for a looseleaf binder (col. 2, ll. 2-8). The folder “is used to cover and retain an insert containing information” (col. 1, ll. 36-37). The folder can have data on its cover sheet (11), such as “ESKCO” in Figure 1, and can have other data such as “PRODUCTS FOR INDUSTRY” on an information sheet (17 in Fig. 1) such that the data shows through a transparent portion of the folder when the information sheet is placed in a pocket (12) of the folder (col. 3, ll. 10-22; Figs. 1 and 2). Alternatively, all of the data can be placed on the information sheet such that it shows through a transparent portion of the cover sheet (col. 3, ll. 23-39; Figs. 3 and 4). In one embodiment the cover sheet has thereon an edge marking (27) that forms a transparent box (26) which some of the data on the information sheet (“ESKCO” in Figs. 3 and 4) shows through when the information sheet is placed in the folder’s pocket (col. 3, ll. 36-39).

Analysis

“Anticipation requires that every limitation of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference.” *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255-56 (Fed. Cir. 1989).

The Appellants argue that Bromer does not teach or suggest information positioned on an insert such that the information can be associated with the appropriate image (Br. 4).

The Examiner argues that each letter in “ESKCO” on the folder’s cover sheet 11 in Bromer’s Figure 1 is an image, and that edge marking 27

and box 26 on the folder's cover sheet 21 in Bromer's Figure 3 is an image (Ans. 3, 8). The Examiner argues that Bromer's inserts (17 in Fig. 1 and 28 in Fig. 3) have thereon information (18 in Fig. 1 and 29 in Fig. 3) "that relates to the plurality of images and the information on the insert is located in a portion on the insert such that it can be readily identified with respect to the plurality of images [with which] it is associated" (Ans. 8-9). The Examiner argues that "letters in area 16 for example provide a company name or logo that is related to the information on the sheet 17 and this information on sheet 17 is positioned such that is [sic, it] can be readily identified with respect to the associated image 16" (Ans. 9).

The Appellants' claims do not merely require that the information on the insert can be readily identified with respect to an associated image. The claims require that the information can be readily identified with respect to which of a plurality of images it is associated. Bromer's information 18 on information sheet 17 can be readily identified with respect to the letters "ESCKO" on the cover sheet. However, because the information is not associated with any particular letter or letters within the name "ESCKO", it cannot be readily identified with respect to which of the letters (i.e., plurality of images) the information is associated. Likewise, the information on the information sheet in Bromer's Figure 3 can be identified with respect to edge marking 27 and the box 26 formed thereby, but because there is no plurality of images and association of the information with particular images, it cannot be readily identified with respect to which of a plurality of images the information is associated.

Conclusion of Law

The Appellants have shown reversible error in the Examiner's determination that Bromer discloses, expressly or inherently, 1) a dual sided album leaf having first and second ply layers secured together to form a pocket therebetween and having a plurality of images on the first and/or second ply layer, and 2) an insert having information thereon such that when the insert is placed within the pocket, it can be readily identified with respect to which of the plurality of images the information is associated.

*Rejections under 35 U.S.C. § 103 of claims 5 and 6
over Bromer in view of Fountain, claim 7 over
Bromer in view of Young, claims 8-11 over Bromer
in view of Hawley, and claim 32 over Bromer*

The Examiner does not rely upon Bromer for any disclosure that would have rendered the invention claimed in any of the Appellants' claims prima facie obvious to one of ordinary skill in the art, and does not rely upon Fountain, Young or Hawley for any disclosure that remedies the deficiency in Bromer (Ans. 6-8).

Accordingly, we conclude that the Examiner has not established a prima facie case of obviousness over those references of the inventions claimed in the Appellants' claims 5-11 and 32.

*Rejections of claims 1, 4 and 12 under 35 U.S.C. § 102(b)
over Liener Chin, and claim 4 under 35 U.S.C. § 103
over Bromer in view of Liener Chin*

Issue

Have the Appellants shown reversible error in the Examiner's determination that A) Liener Chin discloses, expressly or inherently, 1) a dual sided album leaf having first and second ply layers secured together to form a pocket therebetween and having a plurality of images on the first

and/or second ply layer, and 2) an insert having information thereon such that when the insert is placed within the pocket, it can be readily identified with respect to which of the plurality of images the information is associated, or B) Liener Chin and Bromer would have rendered prima facie obvious, to one of ordinary skill in the art, the above dual sided album leaf and insert wherein the outer surfaces of the first and second ply layer each have a plurality of images, and the insert has information thereon with respect to the images on the first and second surfaces?

Findings of Fact

Liener Chin discloses products for “protecting, storing, organizing and/or displaying printed sheets, photographs, clippings from periodicals, handwritten pages, drawings and so forth” (col. 1, ll. 6-9). Liener Chin discloses, in Figures 22 and 27A-D, a tabbed pocket product having numbers (854, 858) printed on transparent front and back sheets (864, 868), and titles printed on front and rear title sheets (890, 880) (or printed on both sides of a single title sheet) such that each title on the title sheet aligns with a number on the front or back sheet when the title sheet is placed in the pocket (col. 11, ll. 23-35; col. 12, ll. 25-40). The tabbed pocket product can have binder holes (col. 12, ll. 27-28; Figs. 22 and 27A-D).

Analysis

The Appellants argue, with respect to the rejection under 35 U.S.C. § 102(b), that Liener Chin’s tabbed pocket product is a sheet protector, not an album leaf (Reply Br. 2). An album, the Appellants argue, is “‘a book or binder with blank pages for mounting a collection, as of stamps or photographs therein’” (Br. 3 quoting Webster’s New Collegiate Dictionary).

That argument is not persuasive because Liener Chin's tabbed pocket product is capable of having stamps or photographs mounted on its front and back sheets.

We note that the Appellants' claims do not require the images to be mounted stamps or photographs. The claims merely require a plurality of images such that it can be readily identified with respect to which of the plurality of images information on the insert is associated. Liener Chin's numbers on the front and back sheets are images, and it can be readily identified with respect to which of those images the titles on the title sheets are associated. Hence, Liener Chin's numbers meet the image requirement of the Appellants' claims.

The Appellants argue that "[s]ince there are images on both the front and backside of the album leaf, it would be nonsensical that the images could be viewed through the ply layers as disclosed in the cited art, as then one image would interfere with the other" (Br. 3). The Appellants also argue that since Liener Chin's front and back sheets "are transparent sheets, it does not provide the plurality of images on an image product as taught and claimed by Applicant" (Br. 4).

Those arguments are not well taken because Liener Chin's numbers, which correspond to the Appellants' images, are on and visible from each of the front and back sheets. Moreover, other images, such as stamps and photographs, can be mounted, pointing outwardly, on the outside or inside of Liener Chin's transparent front and back sheets such that the images on the front sheet are visible only from the front and the images on the back sheet are visible only from the back. Thus, even if, as argued by the Appellants,

the images on an album leaf cannot interfere with each other, Liener Chin's tabbed pocket product can function as an album leaf.

In view of the above-discussed disclosure by Liener Chin, we are not persuaded of reversible error in the rejection of claims 1, 4 and 12 under 35 U.S.C. § 102(b) over Liener Chin or the rejection of claim 4 under 35 U.S.C. § 103 over the combined disclosures of Liener Chin and Bromer.

Conclusion of Law

The Appellants have not shown reversible error in the Examiner's determination that A) Liener Chin discloses, expressly or inherently, 1) a dual sided album leaf having first and second ply layers secured together to form a pocket therebetween and having a plurality of images on the first and/or second ply layer, and 2) an insert having information thereon such that when the insert is placed within the pocket, it can be readily identified with respect to which of the plurality of images the information is associated, or B) Liener Chin and Bromer would have rendered prima facie obvious, to one of ordinary skill in the art, the above dual sided album leaf and insert wherein the outer surfaces of the first and second ply layer each have a plurality of images, and the insert has information thereon with respect to the images on the first and second surfaces.

DECISION/ORDER

The rejections of claims 1, 3 and 12 under 35 U.S.C. § 102(b) over Bromer, claims 5 and 6 under 35 U.S.C. § 103 over Bromer in view of Fountain, claim 7 under 35 U.S.C. § 103 over Bromer in view of Young, claims 8-11 under 35 U.S.C. § 103 over Bromer in view of Hawley, and claim 32 under 35 U.S.C. § 103 over Bromer are reversed. The rejections of

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claims 1, 4 and 12 under 35 U.S.C. § 102(b) over Liener Chin, and claim 4 under 35 U.S.C. § 103 over Bromer in view of Liener Chin are affirmed.

It is ordered that the Examiner's decision is Affirmed-In-Part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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